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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/678,203	10/02/2000	Cornelius Borst	P-3875.09	3753
27581	7590	08/13/2007		
MEDTRONIC, INC. 710 MEDTRONIC PARKWAY NE MINNEAPOLIS, MN 55432-9924				
			EXAMINER	
			NASSER, ROBERT L	
			ART UNIT	PAPER NUMBER
			3735	
			MAIL DATE	DELIVERY MODE
			08/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/678,203

Applicant(s)

BORST ET AL.

Examiner

Robert L. Nasser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21, 23-33 and 35-73 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 48-50 and 66-68 is/are allowed.
- 6) ☒ Claim(s) 1-21, 23-33, 45-65 and 69-73 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 4/10/2007.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

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Applicant correctly noted that the correct effective filing date of the current claims is 10/2/2000, not 10/2/2006.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 13, 32, 33, 35-47, and 63-65 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 13, 32, 33, 35-47, and 63-65 are rejected in that there is no antecedent basis in the specification for two different actuators both of which control spreading of the first and second members away from each other. As shown in figures 34 and 45, there are two actuators disclosed. However, actuator 420 controls spreading, while actuator 360 the angle of the tissue engaging arms relative the longitudinal body. Since this limitation was added via amendment, it constitutes new matter.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6, 8-12, 14-21, 23-26, 28-31, 51-62 69, 70, and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benetti et al 5727569 in view of Vierra et al 5749892 and Hossain et al 6063021. Specifically, in figure 9, Benetti shows first and second suction members on a distal end of a device attached to an actuator, i.e. a first control mechanism, on the proximal end of the device where the actuator selectively controls a spreader, i.e. the pivot 25, to spread the suction members to spread in a parallel manner from a first to a second to a third (and so on) position, where each position is parallel to the others from a in multiple positions. It does not have the actuator on a proximal end of an arm and the spreader on a distal end. Vierra shows a similar device with the claimed configuration. As such, it would have been obvious to modify the device of Benetti to use the configuration of Vierra, as it is merely the substitution of one forceps arrangement for another. In addition, there are not two control mechanisms, one to control movement from a first to a second position and one to control from a second to a third position, where the tissue engaging members are parallel in the first and one of the second or third positions. However, Hossain further teaches using a second control mechanism to control a variable joint 40 controllable by knob 42. Such a joint allows better conformance of the device to the heart. Hence, it would have been obvious to modify the Benetti/Vierra et al to use such a joint, to allow a better fit onto the surface of the heart. Claim 2 is rejected in that the selective spreading allows the members to be stabilized. Claims 4, 6 and 8 are rejected in that the actuator of the combination is mechanical knob controlled by a clinician. Claim 9 is rejected in that the actuator is mechanical. Claims 10-12 are rejected in that the device is capable

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of having a first position with no spacing, a second position spaced by a distance and third distance spaced by a greater distance. Claims 14-16 are rejected in that Vierra further teaches that it is known to attach such a heart stabilizer to an inanimate object, which can be any of the enumerated devices, to prevent movement of the heart during surgery. Hence, it would have been obvious to modify Benetti to use such a coupling device, to improve the surgical process. Claim 17 is rejected in that the first and second surfaces include suction cups coupled to a suction source. Claims 19-21 are rejected in that Hossain et al shows an identical device to Vierra that has a variable joint 40 controllable by knob 42. Such a joint allows better conformance of the device to the heart. Hence, it would have been obvious to modify Vierra et al to use such a joint, to allow a better fit onto the surface of the heart. Claims 22-26, 28 and 30-31 are rejected for the reasons given above. Claims 51 and 54 are rejected in that the members are sized and shaped to engage tissue. Claims 52 and 55 are rejected in that there is a suction lumen open to the atmosphere. Claims 53 and 56 are rejected in that the first and second members are adapted to be coupled to tissue via a contact surface. Claims 57-62 are rejected for the reasons given above. Claims 69, 70, and 72 are rejected in that the control knob of the combination has first and second stop positions corresponding to first and second positions.

Claims 5, 27, 71, and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benetti et al in view of Vierra and Hossain, as applied to claims 1-4, 6, 8-12, 14-21, 23-26, 28-31, 51-62, 69, 70, and 72 further in view of Furnish 5,498,256. Furnish shows a hand lever actuator for forceps. That is biased in a first

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stop position (open) Hence, it would have been obvious to modify the above combination to use the actuator of Furnish, as it is merely the substitution of one known equivalent actuator for another.

Claims 7 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benetti et al in view of Vierra and Hossain, as applied to claims 4, 6, 8-12, 14-21, 23-26, 28-31, 51-62, 69, 70, and 72 further in view of Garrison et al 5613937. In column 15, lines 40-60, Garrison teaches the equivalence of the rotating knob actuator of Benetti/Vierra and the slide actuator recited in the claims. Hence, it would have been obvious to modify the above combination to use the actuator of Garrison, as it is merely the substitution of one known equivalent actuator for another.

Claims 48-50 and 66-68 are allowable in that none of the art teaches spreading the members apart before prior to contacting the tissue and after contacting the tissue, as claimed.

Applicant's arguments filed 5/25/2007 have been fully considered but they are moot in view of the new grounds of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert L. Nasser whose telephone number is 571 272-4731. The examiner can normally be reached on m-f 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor II can be reached on 571 272-4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RLN
July 30, 2007

Robert F. Nassouf
Primary Examiner